

## **REMARKS**

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1-7 are pending in this application. New claims 8-10 use the more limiting transitional phrase “consists of” to describe the light diffusing film. New claims 11-13 repeat previously presented amendments but are ultimately dependent upon claim 3 rather than claim 1. Presuming a proper search was conducted, no further search or consideration is necessitated by this amendment.<sup>1</sup>

No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME**

Claims 1 and 6 was rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. It is believed that the present amendments to claim 1 address the applicants’ concerns. However, should the rejection be maintained, the applicants request suggestions from the Examiner as to how to further address this issue.<sup>2</sup>

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<sup>1</sup> MPEP 904.03 (Conducting the Search) states in part “[i]t is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant’s amendment.”

<sup>2</sup> MPEP 2173.02 states in part:

“The examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, ***not whether more suitable language or modes of expression are available***. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. ***Examiners are encouraged to suggest claim language to applicants to improve clarity***”

### **III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME**

Claims 1 and 5-7 were rejected as allegedly being obvious by Yamashita et al. (US 7,004,610 – “Yamashita”). The applicants request reconsideration of this rejection for the following reasons.

Claims 2-4 were rejected as allegedly being obvious by Yamashita et al. (U.S. Patent 7,004,610 – “the Yamashita patent”) as applied to claim 1 and further in view of Stevenson et al. (U.S. Patent 6,846,089 – “Stevenson”). The applicants request reconsideration of this rejection for the following reasons.

#### **The Yamashita patent is ineligible as prior art**

As the applicants would be willing to file a certified English language translation of the application upon which foreign priority is based, i.e. JP 2003-280168, the applicants can claim priority back to **25 July 2003**. However, the Yamashita patent does not have a 102(e)(2) date and therefore the Yamashita patent would be ineligible as prior art if the applicants are accorded their priority date.

#### **Explanation of why the Yamashita patent is ineligible as prior art**

The method for considering the 102(e) date for the Yamashita patent is similar to Example 5 in MPEP 706.02(f)(1) – (see page 700-34, rev. 6, Sept. 2007 – a copy of this page is attached to the end of this response).

The Yamashita patent was granted from a National Stage (35 U.S.C. 371) application of an International Application (WO 02/25167) which was filed on 25 September 2001, i.e. “on or after 29 November 2000” and was published in Japanese on 28 March 2002.

Because the International Application was filed “on or after 29 November 2000” and was not published in English under PCT Article 21(2), the Yamashita patent, i.e. U.S. Patent 7,004,610, has no 102(e)(2) date. The earliest date upon which the Yamashita patent can be relied upon as prior art is **28 February 2006** which would not qualify the Yamashita patent as

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*or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.” (emphasis added).*

prior art against the applicants' claimed invention for purposes of 35 U.S.C. 102(a) or (b) if the applicants are accorded their priority date, i.e. **25 July 2003**.

**Yamashita publication is also ineligible as prior art**

The PGPub for Yamashita (U.S. Patent Application Publication 2004-0022050) is also ineligible as prior art under 102(e)(1) for similar reasons cited above against the Yamashita patent. As the publication date for the PGPub for Yamashita is **5 February 2004**, the PGPub for Yamashita patent would be ineligible as prior art if the applicants are accorded their priority date, i.e. **25 July 2003**.

**Publication of International Application is eligible as prior art but is published in Japanese**

The publication of the International Application for Yamashita (WO 02/25167 – “the IA publication”) would be eligible as prior art under 35 U.S.C. 102(a) and (b) as it was published on 28 March 2002. *However, this reference is not being used in the rejection of record.*

If the rejection was changed to use the IA publication of Yamashita, it is again noted that the IA publication was published in Japanese. As such, it cannot be presumed that the U.S. publication reflects the text of the IA publication, i.e. without an English language translation, the rejection would be limited to the English language text or other identifiable communications (e.g. figures and drawings).<sup>3</sup>

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the

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<sup>3</sup> See MPEP 706.02, section I – “Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)”

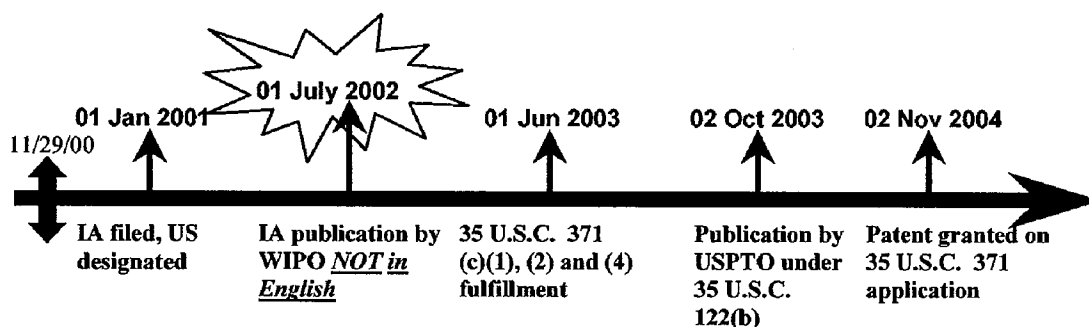
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Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By: Howard C. Lee  
Marilyn M. Brogan    Howard C. Lee  
Reg. No. 31,223      Reg. No. 48,104  
Telephone:    (212) 588-0800  
Facsimile:    (212) 588-0500

**Example 5:** References based on the **national stage (35 U.S.C. 371)** of an **International Application filed on or after November 29, 2000** and which was **not** published in **English** under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was **not** published in **English** under PCT Article 21(2) have no 35 U.S.C. 102(e) prior art date at all. According to 35 U.S.C. 102(e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102(e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English, regardless of whether the international application entered the national stage. Such references may be applied under 35 U.S.C. 102(a) or (b) as of their publication dates, but never under 35 U.S.C. 102(e).



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.

The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None.

The 35 U.S.C. 102(e)(2) date for the Patent is: None.

The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 July 2002).

#### Additional \*Benefit Claims:

If the IA properly claimed **\*\*>the benefit of<** to any earlier-filed U.S. application (whether provisional or non-provisional), there would still be no 35 U.S.C. 102(e) date for all the references.

If a later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application.